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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER VEZERIS, JAMES A				
ART UNIT		PAPER NUMBER		
3693				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/716,650

**Applicant(s)**

MCLIESH ET AL.

**Examiner**

JAMES A. VEZERIS

**Art Unit**

3693

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/13/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-25 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-25 and 27-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **Final Action**

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Response to Arguments**

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner stated in the original action that "It is therefor obvious to combine CD and Harycki to allow for the transferring of funds. A person skilled in the art would be motivated to

combine the two references because it allows a user to make more money through incentives and higher returns."

3. Applicant's arguments with respect to claims 1-12, 14-25, and 27-38 have been considered but are moot in view of the new ground(s) of rejection.

### **Detailed Action**

#### **Claim Rejections- 35 U.S.C. 102(b)**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1, 11, 14, 17, 24, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by "Transfer fees not fair, small brokers say: Boost cost of hiring: Head of brokerage committee plans to launch complaint" by DeCloet. (Hereinafter "DeCloet")

#### **Regarding Claims 1, 14, and 27.**

DeCloet teaches an investor having a first financial instrument, a second financial instrument, the method comprising:

receiving funds associated with the first financial instrument held with a first financial institution, the funds having been reduced by a penalty for closing the first financial instrument and are received at a second financial institution;

increasing, by the second financial institution, the funds by a first amount based

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on the reduced funds due to the penalty; and

transferring the increased funds to the second financial instrument.

DeCloet teaches a first financial instrument being closed and charged an exit fee.

This fee is taking from the account during the transfer. The second institution that is creating a second financial instrument refunds the second instrument the exit fees.

**Regarding Claims 11, 24, and 37.**

DeCloet further teaches the penalty is an early withdraw penalty.

**Claim Rejections- 35 U.S.C. 103(a)**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 2-10, 15-23, and 28-36 rejected under 35 U.S.C. 103(a) as being unpatentable over DeCloet in further in view of US-PG Pub 2002/0077966 to Harycki et al. (Hereinafter "Harycki").

**Regarding Claims 2, 15, and 28.**

DeCloet fails to further teach providing an investor holding the second financial instrument an option to transfer the funds to a third financial instrument based on predetermined account criteria.

Harycki teaches providing an investor holding the second financial instrument an option to transfer the funds to a third financial instrument based on predetermined account criteria. (See Harycki paragraph 58, 59, and 60) Examiner notes that Harycki provides the option to choose new setting on an account, making a new financial instrument.

It would be obvious for one skilled in the art to combine DeCloet with Harycki to provide an investor holding the second financial instrument an option to transfer the funds to a third financial instrument based on predetermined account criteria.

There is motivation to do so because it would allow the system of Harycki to provide more account options to the user.

**Regarding Claims 3, 16, and 29.**

DeCloet fails to further teach the predetermined account criteria comprises a predetermined period of time.

Harycki teaches the predetermined account criteria comprises a predetermined period of time. (See Harycki paragraph 58, 59, and 60) Harycki limits when a user can access the account settings.

It would be obvious for one skilled in the art to combine DeCloet with Harycki to allow predetermined account criteria comprising a predetermined period of time.

There is motivation to do so because it would allow the system of Harycki to provide more account options to the user.

**Regarding Claims 4, 17, and 30.**

DeCloet fails to further teach providing an investor holding the second financial instrument an option to change the terms of the second financial instrument based on predetermined account criteria.

Harycki teaches providing an investor holding the second financial instrument an option to change the terms of the second financial instrument based on predetermined account criteria. (See Harycki paragraph 58, 59, and 60)

It would be obvious for one skilled in the art to combine DeCloet with Harycki to provide an investor holding the second financial instrument an option to change the terms of the second financial instrument based on predetermined account criteria.

There is motivation to do so because it would allow the system of Harycki to provide more account options to the user when the user was a loyal customer.

**Regarding Claims 5, 18, and 31.**

DeCloet fails to further teach the predetermined account criteria comprises a predetermined period of time.

Harycki teaches the predetermined account criteria comprises a predetermined period of time. (See Harycki paragraph 58, 59, and 60)

It would be obvious for one skilled in the art to combine DeCloet with Harycki to have the predetermined account criteria comprise a predetermined period of time.

There is motivation to do so because it would allow the system of Harycki to provide more account options to the user when the user was a loyal customer.

**Regarding Claims 6, 19, and 32.**

DeCloet fails to further teach the third financial instrument has a rate of return greater than the second financial instrument.

Harycki teaches the third financial instrument has a rate of return greater than the second financial instrument. (See Harycki paragraph 58, 59, and 60)

It would be obvious for one skilled in the art to combine DeCloet with Harycki to have the third financial instrument have a rate of return greater than the second financial instrument.

There is motivation to do so because it would allow the system of Harycki to provide more account options to the user and to reward them for being a loyal user.

**Regarding Claims 7, 20, and 33.**

DeCloet fails to further teach the second financial instrument and the third financial instrument are managed by the second financial institution.

Harycki teaches teach the second financial instrument and the third financial instrument are managed by the second financial institution. (See Harycki paragraph 58, 59, and 60)

It would be obvious for one skilled in the art to combine DeCloet with Harycki to have the second financial instrument and the third financial instrument managed by the second financial institution.



There is motivation to do so because it would allow the system of Harycki to continue doing business with the user while increasing loyalty.

**Regarding Claims 8, 21, and 34.**

DeCloet further teaches at least one of the first financial instrument, the second financial instrument, and the third financial instrument comprise at least one of a certificate of deposit, a jumbo certificate of deposit, a promissory note, and a time deposit.

**Regarding Claims 9, 22, and 35.**

DeCloet fails to further teach at least one of receiving the funds, increasing the funds, and transferring the increased funds further comprises communicating over a network.

Harycki teaches at least one of receiving the funds, increasing the funds, and transferring the increased funds further comprises communicating over a network. (See Harycki paragraph 64)

It would be obvious for one skilled in the art to combine DeCloet with Harycki to receive and increase the funds, and transfer the increased funds over a network.

There is motivation to do so because it would allow the system of Harycki to provide an easy user interface.

**Regarding Claims 10, 23, and 36.**

DeCloet fails to further teach communicating over the network further comprises communicating with a user device on the network, the user device being located in at

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least one of a home, an office, a store, a retail center kiosk, and an office of a financial institution.

Harycki teaches communicating over the network further comprises communicating with a user device on the network, the user device being located in at least one of a home, an office, a store, a retail center kiosk, and an office of a financial institution. (See Harycki paragraph 64)

It would be obvious for one skilled in the art to combine DeCloet with Harycki to communicate with a user device on the network, the user device being located in at least one of a home, an office, a store, a retail center kiosk, and an office of a financial institution.

There is motivation to do so because it would allow the system of Harycki to provide an easy user interface.

9. Claims 12, 25, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCloet in view of Harycki in further view of "CD's are Not Risk Free, So Shop Around" (Hereinafter "CD"), by the Pittsburgh Post.

**Regarding Claims 12, 25, and 38.**

DeCloet fails to further teach the penalty is an amount equal to between three and six months interest on the first financial instrument.

CD teaches the penalty is an amount equal to between three and six months interest on the first financial instrument. (See CD paragraph 7)

It is therefore obvious to combine DeCloet, CD, and Harycki to use a penalty in an amount equal to between three and six months interest on the first financial instrument.

There is motivation to do so because CD penalties are well known in the art and applying to the penalty to DeCloet and Harycki allows for a realistic penalty for the early transfer.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. VEZERIS whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

/JAMES A VEZERIS/  
Examiner, Art Unit 3693

5/22/2008